



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

20

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/051,834	01/16/2002	Sonny Bui	50325-0646	3081
29989	7590	03/10/2005	EXAMINER	
HICKMAN PALERMO TRUONG & BECKER, LLP				HALIM, SAHERA
2055 GATEWAY PLACE				ART UNIT
SUITE 550				PAPER NUMBER
SAN JOSE, CA 95110				2157

DATE MAILED: 03/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/051,834	BUI ET AL.	
	Examiner	Art Unit	
	Sahera Halim	2157	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 16 January 2002.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-11,17-20,22,24-30,35 and 43-46 is/are rejected.
- 7) Claim(s) 12-16,21,23,31-34 and 38-41 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 16 January 2002 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____

DETAILED ACTION

1. This Office Action is in respond to communication filled on January 16, 2002.

NON-STATUTORY DOUBLE PATENTING

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1 -11, 17 -18, 19 - 20,22, 24 - 30, 35 - 36, are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1-11, 12 -13, 14 - 15, 16, 17 – 19, 21 – 24 and 25 – 26 of U.S. Patent No. 6,412,007. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following reasons:

Claims 1-11 of the instant application have the same limitations as the claimed limitations of claims 1-11 of the Patent No. 6,412,007.

Claims 17-18 of the instant application have the same limitations as the claimed limitations of claims 12-13 of the Patent No. 6,412,007.

Claims 19- 20 of the instant application have the same limitations as the claimed limitations of claims 14-15 of the Patent No. 6,412,007.

Claim 22 of the instant application has the same limitations as the claimed limitations of claim 16 of the Patent No. 6,412,007.

Claims 24 -30 of the instant application have the same limitations as the claimed limitations of claims 17 – 19 and 21-24 of the Patent No. 6,412,007.

All the limitations of the above claims (claims of the instant application) are the same as the corresponding claimed limitations of the claims of the Patent No. 6,412,007 (listed above), except that the invention of the instant application is claiming a computer-readable medium carrying one or more sequences of instructions to process/control the steps of the method claims of Patent No. 6,412,007. However, it would have been obvious for a person having ordinary skill in the art at the time the invention was made to convert the steps of the method to a computer readable program code because it will extent the utilization of the invention disclosed in Patent No. 6,412,007.

4. Claims 43 -46, are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 12, 14, and 25 of U.S. Patent No. 6,412,007. Although the conflicting claims are not identical, they are not patentably distinct from each other because all the limitations of claims 43 – 46 of the instant application are identical to the limitations of claims 1, 12, 14 and 25 of U.S. Patent No. 6,412,007, except that invention of the instant application is claiming a computer-readable apparatus to process/control the method claims of the Patent No. 6,412,007. However, it would have been obvious to a

person having ordinary skill in the art at time the invention was to use the steps of the method to a computer readable apparatus because it will extent the utilization of the invention disclosed in Patent No. 6,412,007.

ANTICIPATION REJECTION

1. Claim 27 of U.S. Patent No. 6,412,007 contain every element of claims 37 of the instant application and as such anticipate claim 37 of the instant application.

"A later patent claim is not patentably distinct from an earlier patent claim if the later claim is obvious over, or **anticipated by**, the earlier claim. In re Longi, 759 F.2d at 896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting because the claims at issue were obvious over claims in four prior art patents); In re Berg, 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998) (affirming a holding of obviousness-type double patenting where a patent application claim to a genus is anticipated by a patent claim to a species within that genus). " ELI LILLY AND COMPANY v BARR LABORATORIES, INC., United States Court of Appeals for the Federal Circuit, ON PETITION FOR REHEARING EN BANC (DECIDED: May 30, 2001).

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows:

The claimed invention in the instant application (claim 37) is same as the claimed invention in the patent (claim 27 of U. S. Patent No. 6,434,627) by replacing/changing a name of

a limitation such as a server to a counter. No new invention or new improvement is being claimed in the instant application (claim 37).

Claim Objections

5. Claims 12 – 16, 21, 23, 31 – 34, and 38 – 41 are objected to as being dependent upon rejected base claims, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

CONTACT INFORMATION

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sahera Halim whose telephone number is (703) 305-8054. The examiner can normally be reached on M-F from 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (571) 272-4001. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sahera Halim
Patent Examiner
AU : 2157

February 24, 2005



ARIO ETIENNE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100